

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Applicants:** Stewart et al.

**Examiner:** Campbell, Joshua D.

**Title:** SYSTEM, METHOD AND RECORDABLE MEDIUM FOR PRINTING SERVICES OVER A NETWORK AND GRAPHICAL USER INTERFACE

**Docket No.:** 424992000200  
(MIME-0003)

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Commissioner for Patents  
P.O. Box 1450  
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**BRIEF OF APPELLANTS**

This is an appeal from the Final Rejection dated 4 April 2006, rejecting claims 12-33.

This Brief is accompanied by the requisite fee set forth in 37 C.F.R. 1.17(c).

**REAL PARTY IN INTEREST**

Mimeo.com, Inc. is the real party in interest.

**RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences.

## **STATUS OF CLAIMS**

As filed, this case included claims 1-11. Subsequently, claims 1-11 were canceled and claims 12-33 were added. Claims 12-33 remain pending. Claims 12-33 stand rejected and form the basis of this appeal.

## **STATUS OF AMENDMENTS**

No amendment has been submitted subsequent to the Final Office Action dated 4 April 2006.

## **SUMMARY OF CLAIMED SUBJECT MATTER**

The present invention provides a solution for previewing and/or printing a document over a network. Specifically, the present invention provides a solution in which a print file is generated on a client based on the document (see, e.g., page 17, lines 12-15; FIGS. 6-7). The print file and configuration information for the document are received at a server (see, e.g., page 17, lines 15-19; FIGS. 7, 17B-F), which generates a preview of a configured copy of the document and provides the preview for display at the client (see, e.g., page 21, lines 1-9; page 25, lines 3-10; FIGS. 17B-F). One or more copies of the document can be printed and delivered to one or more addresses (see, e.g., page 24, lines 3-11; FIG. 16A). Memo information also can be obtained and a customized memo can be included for each recipient (see, e.g., page 25, lines 15-17; FIG. 17K).

Claim 12 claims a method of previewing a document over a network (see, e.g., page 8, lines 6-10; FIG. 7, 620), the method comprising: providing system software for use on a client (see, e.g., page 10, lines 13-16; FIG. 13), wherein the system software allows a user of the client

to generate a print file on the client based on the document using a local application (see, e.g., page 17, lines 12-14; FIG. 7, 605); obtaining the print file from the client on a server (see, e.g., page 13, lines 8-11; page 17, lines 15-18; FIG. 7, 610); obtaining configuration information for the document on the server (see, e.g., page 16, lines 7-10; page 17, lines 17-19; FIG. 7, 625); generating a preview of a configured copy of the document on the server based on the print file and the configuration information (see, e.g., page 21, lines 1-9; FIGS. 17B-F); and providing the preview for display at the client (see, e.g., page 25, lines 3-10; FIG. 17B-F).

Claim 17 claims a method of printing a document over a network (see, e.g., page 17, line 10-page 18, line 7; FIG. 7, 660), the method comprising: obtaining a print file on a server (see, e.g., page 13, lines 8-11; page 17, lines 15-18; FIG. 7, 610), wherein the print file is based on the document (see, e.g., page 17, lines 12-14; FIG. 7, 605); obtaining configuration information for the document on the server (see, e.g., page 16, lines 7-10; page 17, lines 17-19; FIG. 7, 625), wherein the configuration information includes at least one printing option for the document (see, e.g., page 16, lines 7-10); printing a plurality of copies of the document based on the print file and the configuration information (see, e.g., page 18, lines 1-6); obtaining a plurality of delivery addresses on the server (see, e.g., page 25, lines 13-15; FIG. 17I); obtaining memo information for each of the plurality of delivery addresses (see, e.g., page 25, lines 15-17; FIG. 17K), wherein the memo information is customized for a recipient at each of the plurality of delivery addresses (see, e.g., page 25, lines 15-17; FIG. 17K); printing a customized memo based on the customized memo information for each of the plurality of delivery addresses (see, e.g., page 18, lines 3-5); and delivering at least one of the plurality of copies of the document and the corresponding customized memo to each of the plurality of delivery addresses (see, e.g., page 18, lines 5-7).

Claim 20 claims a system for previewing a document over a network (see, e.g., page 8, lines 6-10; FIG. 2, 300), the system comprising: system software that generates a print file on a client based on the document and communicates the print file to a server (see, e.g., page 9, line 10-page 11, line 8; FIG. 2, 310b), wherein the print file can be directly printed by a printer (see, e.g., page 12, lines 15-17; FIG. 7, 605); means for obtaining the print file from the client and configuration information for the document on the server (see, e.g., page 17, lines 1-19; FIG. 6, 320); means for generating a preview of a configured copy of the document based on the print file and the configuration information on the server (see, e.g., page 17, lines 17-19; FIGS. 17B-F); and means for providing the preview for display at the client (see, e.g., page 17, lines 16-19; FIGS. 17B-F).

Claim 24 claims a system for printing a document over a network (see, e.g., page 16, line 17-page 17, line 9; FIG. 6, 300), the system comprising: means for obtaining a print file from a client and configuration information for the document on a server (see, e.g., page 17, lines 1-19; FIG. 6, 320), wherein the print file can be directly printed by a printer (see, e.g., page 12, lines 15-17; FIG. 7, 605); means for generating a preview of a configured copy of the document based on the print file and the configuration information on the server (see, e.g., page 17, lines 17-19; FIGS. 17B-F); means for providing the preview for display at the client (see, e.g., page 17, lines 16-19; FIGS. 17B-F); means for printing a copy of the document using the print file (see, e.g., page 18, lines 1-5; FIG. 6, 300c); and means for assembling the copy based on the configuration information (see, e.g., page 17, lines 6-9; FIG. 6, 300c).

Claim 28 claims a graphical user interface (see, e.g., page 25, lines 3-10; FIGS. 17B-F) comprising: a preview area for displaying a preview of a configured copy of a document (see, e.g., page 25, lines 3-10; FIGS. 17B-F), wherein the preview is based on a print file and

configuration information for the document (see, e.g., page 25, lines 3-10; FIGS. 17B-F); a navigation area that enables a user to select a portion of the preview displayed in the preview area (see, e.g., page 25, lines 3-10; FIGS. 17B-F); an estimate area for displaying a price estimate for the configured copy (see, e.g., page 25, lines 3-10; FIGS. 17B-F), wherein the price estimate is based on the print file and the configuration information (see, e.g., page 25, lines 3-10; FIGS. 17B-F); and a configuration area that enables the user to alter the configuration information (see, e.g., page 25, lines 3-10; FIGS. 17B-F), wherein the preview area and the estimate area are automatically updated based on the altered configuration information (see, e.g., page 25, lines 3-10; FIGS. 17B-F).

Claim 29 claims a computer program product comprising a computer useable medium having computer readable program code embodied therein for previewing a document (see, e.g., page 8, lines 6-10; FIG. 2, 300), the program product comprising: program code for generating a print file on a client based on the document (see, e.g., page 12, lines 2-4; FIG. 2, 310b), wherein the print file can be directly printed by a printer (see, e.g., page 12, lines 15-17; FIG. 7, 605); program code for communicating the print file to a server (see, e.g., page 12, lines 4-6; FIG. 3, 310c); program code for installing the program code for generating and program code for communicating on the client (see, e.g., page 13, lines 6-7; page 22, lines 9-13; FIG. 13), wherein the program code for installing causes an entry to be added to a list of available printers for the client (see, e.g., page 23, lines 3-5; FIGS. 15B-C); program code for obtaining configuration information for the document (see, e.g., page 17, lines 17-19; FIG. 6, 625); program code for generating a preview based on the print file and the configuration information (see, e.g., page 17, lines 17-19; FIGS. 17B-F); and program code for displaying the preview on the client (see, e.g., page 14, lines 14-16; FIG. 2, 310d).

Claim 31 claims a computer program product comprising a computer useable medium having computer readable program code embodied therein for printing a document (see, e.g., page 16, line 17-page 17, line 9; FIG. 6, 300), the program product comprising: program code for obtaining a print file and configuration information communicated over a network (see, e.g., page 17, lines 1-19; FIG. 6, 320), wherein the print file is based on the document and the print file can be directly printed by a printer (see, e.g., page 12, lines 15-17; FIG. 7, 605); program code for printing a plurality of copies of the document based on the print file and the configuration information (see, e.g., page 18, lines 1-6); program code for obtaining a plurality of delivery addresses (see, e.g., page 25, lines 13-15; FIG. 17I); program code for obtaining memo information for each of the plurality of delivery addresses (see, e.g., page 25, lines 15-17; FIG. 17K), wherein the memo information is customized for a recipient at each of the plurality of delivery addresses (see, e.g., page 25, lines 15-17; FIG. 17K); and program code for printing a customized memo based on the customized memo information for each of the plurality of delivery addresses (see, e.g., page 18, lines 3-5).

### **GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

- I. Claims 12-27 and 29-33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,615,234 (Adamske).
- II. Claim 28 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Adamske in view of U.S. Patent No. 5,873,073 (Bresnan).

## ARGUMENT

### I. Rejection of claims 12-27 and 29-33 as being unpatentable over Adamske

Appellants respectfully submit that the rejection of claims 12-27 and 29-33 under 35 U.S.C. §103(a) as allegedly being unpatentable over Adamske is defective.

In order to establish a *prima facie* case of obviousness, the Examiner must show that (1) every feature is taught or suggested by Adamske; (2) Adamske or generally available knowledge suggests or motivates the modification(s); and (3) one would have a reasonable expectation of success. MPEP 2143. Because the Examiner fails to present a *prima facie* case of obviousness, Appellants respectfully submit that the rejection under 35 U.S.C. 103(a) is defective and request overrule of the rejection.

#### A. Claim 12

With respect to claim 12, Appellants respectfully submit that the Examiner fails to show that every feature of the claimed invention is taught or suggested by Adamske. For example, contrary to the Examiner's assertion, Adamske fails to teach or suggest the claimed generating a preview of a configured copy of the document on the server based on a print file and configuration information. In support of the rejection, the Examiner cites column 5, line 64 through column 7, line 15 of Adamske as allegedly teaching this feature. Appellants respectfully traverse this holding.

The cited portion of Adamske teaches creating web-viewable print preview files by converting a converted printable electronic document into a series of graphical preview images. Adamske, col. 6, lines 1-7. "At the print preview stage, user 10 can see the document as it will print... Based on this preview..., user 10 can make changes to the electronic document, re-upload the electronic document for conversion, and preview the document once again..." Adamske, col.

3, line 64-col. 4, line 2. Subsequently, “[a]fter user 10 verifies the print preview, at operational screen 70 user 10 can select media options..., output handling options..., and destination(s)/recipient(s).” Adamske, col. 6, lines 58-62. Consequently, contrary to the Examiner’s assertion, Adamske fails to teach, *inter alia*, the claimed generation of a preview based on anything other than a converted printable electronic document, which may be generated from a modified and re-uploaded electronic document.

In response to Appellants’ arguments, the Examiner states that “[w]hen the preview is view[ed] at any point the user may make changes to the document and generate a new preview”. Final Office Action dated 4 April 2006, p. 12. Appellants acknowledge that this portion of the Examiner’s statement is accurate as indicated in the discussion at col. 3, line 64-col. 4, line 2 of Adamske. However, the Examiner then alleges that the changes “would include changing configuration options such as black and white or color printing which could then be incorporated into the new preview”. Final Office Action, p. 12. In support of this conclusion, the Examiner cites col. 6, line 58-col. 7, line 15 and col. 3, line 64-col. 4, line 8 of Adamske.

Appellants note that col. 6, line 58-col. 7, line 15, the only portion of Adamske that discusses the selection of color or black and white printing (col. 6, line 60), expressly discusses options selected “[a]fter user 10 verifies the print preview”. Adamske, col. 6, line 58. To this extent, the color or black and white selection is performed using operational screen 70 (col. 6, lines 58-59), which does not enable the user to modify the electronic document (FIG. 3). Clearly, contrary to the Examiner’s assertion, the selection of color or black and white printing discussed in col. 6, line 60 is unrelated to modifying an electronic document that then must be re-uploaded and converted to generate a print preview as discussed at col. 3, line 64-col. 4, line 2 of Adamske.

In an Advisory Action dated 22 June 2006, the Examiner states that “Adamske discloses that a server may create a preview version of the document... if the server has the print file and configuration information which can be obtained via the web interface”. Advisory Action, Continuation of 11. However, Appellants again note that Adamske fails to disclose the use of anything other than the print file in generating the preview. See, e.g., Adamske, col. 6, lines 1-23. To this extent, Appellants submit that the Examiner’s allegation that the server can create a preview if it has configuration information is inaccurate.

In light of the above, Appellants respectfully submit that the Examiner has failed to show that Adamske teaches or suggests each and every feature of the claimed invention. As a result, Appellants respectfully request overrule of the rejection of claim 12 and claims 13-16 and 32-33, which depend therefrom, as allegedly being unpatentable over Adamske.

## **B. Claim 17**

With respect to claim 17, Appellants respectfully submit that the Examiner fails to show that every feature of the claimed invention is taught or suggested by Adamske. For example, the Examiner fails to show that Adamske teaches the claimed obtaining memo information, printing a customized memo, and delivering steps. In support of the rejection, the Examiner cites col. 7, lines 16-56 as allegedly teaching these features. Final Office Action, p. 4. Appellants note that Adamske fails to include any discussion of a memo let alone the claimed customized memo. Rather, Adamske only discusses that “the print job that produces the hard copy document can also include a print out of the packaging instructions selected by the user, a cover sheet, and a shipping label (if applicable).” Adamske, col. 7, lines 40-43. To this extent, Adamske lacks any mention of obtaining memo information that is customized for a recipient at each of a plurality of

delivery addresses, let alone printing and delivering the customized memo along with the one or more copies of the document to each of the delivery addresses.

In response to Appellants' arguments, the Examiner states that "Adamske discloses that a cover sheet and shipping label are received from the client..., and in order for the system to work, at least the shipping label would have to be tailored to each specific recipient, otherwise the document would be improperly shipped." Final Office Action, p. 12. To this extent, the Examiner apparently alleges that a "shipping label" teaches Appellants' claimed "customized memo". Appellants strenuously traverse this interpretation of Adamske.

The term "memo" is a commonly used short form of memorandum, which is most commonly defined as "a short note written as a reminder" or "a written record or communication, as in a business office". The American Heritage® Dictionary of the English Language, Fourth Edition, Houghton Mifflin Company, 2000 (available at [dictionary.reference.com](http://dictionary.reference.com)). In business, memo also can mean "a business statement made by a consignor about a shipment of goods that may be returned". *Id.* In sharp contrast, a shipping label comprises a label that is attached to a shipping unit and includes data. Definition of "shipping label" available at [www.eyefortransport.com/glossary/st.shtml](http://www.eyefortransport.com/glossary/st.shtml). For example, under the Examiner's interpretation, the shipping label apparently includes a delivery address ("otherwise the document would be improperly shipped").

Even if, *arguendo*, the Examiner's interpretation of Adamske's shipping label is accurate, the shipping label does not reasonably teach or suggest Appellants' claimed customized memo. For example, a memo would not be attached to a shipping unit, but would rather inherently be included as part of the shipment enclosed within the shipping unit. Further, Appellants' claimed customized memo is printed based on customized memo information. The claimed customized

memo information is necessarily distinct from the claimed plurality of delivery addresses, which are separately obtained in the claimed invention. However, under the Examiner's interpretation of the claimed customized memo, the only information that is different for each "memo" is the delivery address.

In light of the above, Appellants respectfully submit that the Examiner has failed to show that Adamske teaches or suggests each and every feature of the claimed invention. As a result, Appellants respectfully request overrule of the rejection of claim 17 and claims 18-19, which depend therefrom, as allegedly being unpatentable over Adamske.

## **C. Claim 20**

### **1. Preview of Document**

With respect to claim 20, Appellants respectfully submit that the Examiner fails to show that every feature of the claimed invention is taught or suggested by Adamske. For example, as previously argued with respect to claim 12, contrary to the Examiner's assertion, Adamske fails to teach or suggest the claimed means for generating a preview of a configured copy of the document based on the print file and the configuration information on the server. To this extent, Appellants herein incorporate the arguments presented above with respect to claim 12.

### **2. System Software**

Further, the Examiner fails to show that Adamske teaches the claimed system software that generates a print file on a client based on the document and communicates the print file to a server, wherein the print file can be directly printed by a printer. In support of the rejection, the Examiner cites column 5, line 64 through column 7, line 15 of Adamske as allegedly teaching this feature. Final Office Action, pp. 2-3 (included in rejection of claim 12). Appellants respectfully traverse this holding.

### **a. Teachings of Adamske**

Adamske generally discusses two embodiments for a system and method for delivering an electronic document over a network. Under both embodiments, “the electronic document is converted to a user-viewable print preview format that is displayed to user 10 at the user’s computer.” Adamske, col. 3, lines 57-59.

In the first embodiment, discussed from column 4, line 61 through column 6, line 23 of Adamske, a user uploads an electronic document from a client computer to a web server. See, e.g., Adamske, col. 5, lines 15-16. The electronic document is then converted to a portable printable format on an application translation server. Adamske, col. 5, lines 18-66. In order to perform the conversion, “the application translation program [on the application translation server] houses the variety of client applications that users use to create electronic documents.” Adamske, col. 5, lines 19-21. In this embodiment, the conversion results in a “converted printable electronic document (e.g., in a PostScript format).” Adamske, col. 5, lines 64-66. “The converted printable electronic document is then processed at web server 22 to create web-viewable print preview files for user 10 to view.” Adamske, col. 6, lines 1-3.

In the second embodiment, discussed from column 6, lines 24-57 of Adamske, “the client computer includes a print driver program... that is executable to convert the electronic document and provide the print preview capability prior to uploading to the web server.” Adamske, col. 6, lines 34-38. In particular, the print driver program “creates a metafile from the electronic document. This metafile provides user 10 a viewable representation of how the hard copy will look upon printing at printer 40.” Adamske, col. 6, lines 46-49. Subsequently, the user “sends this metafile to [the application] translation server through web server and the conversion into a

printable (e.g., PostScript) version is performed as previously described.” Adamske, col. 6, lines 49-52.

In both embodiments discussed in Adamske, a printable version of the electronic document is expressly generated on an application translation server (e.g., col. 5, lines 18-19, 64-66 and col. 6, lines 49-52) rather than by system software on a client as in the claimed invention.

### **b. Interpretations of Adamske by the Examiner**

#### **i. Creation of Print File in First Embodiment Cited**

In response to Appellants’ arguments, the Examiner alleges that “in the first embodiment cited Adamske teaches that software used on the client can be used to generate a print file and a print preview file”. Final Office Action, p. 11. Appellants strenuously traverse this conclusion. The Examiner cites col. 6, lines 24-42 of Adamske in support of this statement. Final Office Action, p. 11. However, this portion is devoid of any mention of creating a print file. In fact, in the following paragraph of Adamske (col. 6, lines 43-57), which discusses the functionality of print driver program 14 in greater detail, Adamske expressly states that the print file is generated on the application translation server (col. 6, lines 49-52), not by any software used on the client.

#### **ii. Interpretation of “Conversion”**

The Examiner also states that “[t]he conversion performed by a print driver program performs [sic] is equal to the conversion performed on the server in the alternate embodiment, which is converting the document into a printable electronic document (e.g. PostScript)”. Final Office Action, p. 11. Appellants strenuously traverse this conclusion. In particular, contrary to the Examiner’s assertion, the equivalent conversions taught by Adamske are from an electronic document “to a user-viewable print preview format.” Adamske, col. 3, lines 57-58. In one embodiment, discussed from column 4, line 61 through column 6, line 23, the electronic

document is converted to a printable electronic document, which is used to create web-viewable print preview files. In the second embodiment, discussed from column 6, lines 24-57, the electronic document is used to create a metafile that provides a viewable representation of how the hard copy document will look. In fact, in the alternate embodiment, Adamske expressly states that the metafile is not a printable version of the electronic document since it is provided to the application translation server for “conversion into a printable (e.g., PostScript) version”. Adamske, col. 6, lines 49-52.

### **iii. Definition of print driver**

The Examiner also states that “[b]y definition a print driver acts as an interpreter between the operating system or application software and the particular make and model of printer you’re trying to talk to, or in other words a print driver is used to place the data you are working with in condition to be understood by the printing device you are using, or in other words interpreting the file into a file that can be directly printed by the printer.” Final Office Action, pp. 11-12. Appellants strenuously traverse this conclusion.

While print drivers frequently perform the functions described by the Examiner, such functions are not necessarily performed by a print driver. To this extent, Adamske’s description of the functions performed by the print driver program expressly contradicts the definition used by the Examiner. In particular, Adamske expressly states that its print driver program does not “act[] as an interpreter between the operating system or application software and the particular make and model of printer”, is not “used to place the data you are working with in condition to be understood by the printing device you are using”, or “interpret[] the file into a file that can be directly printed by the printer”. To the contrary, Adamske expressly states that the print driver program “creates a metafile from the electronic document. This metafile provides user 10 a

viewable representation of how the hard copy document will look upon printing at printer 40.” Adamske, col. 6, lines 46-49. However, the metafile cannot be directly printed by the printer. In sharp contrast, Adamske expressly states that the metafile can be sent to translation server 24 where “the conversion into a printable (e.g., PostScript) version is performed as previously described.” Adamske, col. 6, lines 50-52.

### **c. Conclusion**

In light of the above, Adamske clearly does not teach, under either embodiment or the combination thereof, generating a print file on a client and communicating the print file to a server. In sharp contrast, the claimed invention includes system software that generates a print file that can be directly printed by a printer on a client based on the document and communicates the print file to a server. As a result, Adamske fails to teach or suggest the claimed system software.

### **3. Motivation for Modifications**

Additionally, the Examiner fails to show that Adamske or generally available knowledge provides proper motivation for the modifications. As the Federal Circuit discussed extensively in *In re Lee*, 277 F.3d 1338; 61 U.S.P.Q.2D (BNA) 1430 (Fed. Cir. 2002), “[w]hen patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.” Citing *In re Dance*, 160 F.3d 1339, 1343, 48 U.S.P.Q.2D (BNA) 1635, 1637 (Fed. Cir. 1998), the *Lee* Court goes on to state that “there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant”. *Id.*

The need to show the motivation with specificity has long been recognized by the courts.

*Id.* For example, the *Lee* Court cites *In re Kotzab* for the legal requirement that “particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”. *Id.*; *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2D (BNA) 1313, 1317 (Fed. Cir. 2000). Further, the *Lee* Court cites *In re Rouffet* for the legal requirement that a proper showing of motivation, “even when the level of skill in the art is high, ... must identify specifically the principle, known to one of ordinary skill, that suggests the claimed invention.” *Id.*; *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2D (BNA) 1453, 1459 (Fed. Cir. 1998).

Adamske provides two embodiments for network-based document delivery. The Examiner primarily relies on the second embodiment in which the client performs some of the processing, e.g., generates a metafile and print preview. Adamske, col. 6, lines 24-57. The Examiner proposes to modify this embodiment with teachings of the first embodiment in which the client sends an electronic document to a server and displays a preview in a browser. Adamske, col. 4, line 61-col. 6, line 23. The Examiner’s motivation for the modifications is to “reduce the processing load at the client.” Final Office Action, p. 12.

However, the first embodiment of Adamske (col. 4, line 61-col. 6, line 23) provides a solution in which the processing load at the client is reduced from that in the second embodiment. As a result, by its express teachings, Adamske has already addressed the motivation cited by the Examiner and teaches away from the Examiner’s proposed modifications and Appellants’ claimed invention. Since proper motivation is not found in Adamske, Appellants respectfully submit that the Examiner fails to show that Adamske or the prior art

provides proper motivation for the modifications proposed by the Examiner without using the hindsight of the present invention.

#### **4. Conclusion**

In light of the above, Appellants respectfully submit that the Examiner has failed to show that Adamske teaches or suggests each and every feature of the claimed invention and the Examiner has failed to provide a proper motivation for the modifications. As a result, Appellants respectfully request overrule of the rejection of claim 20 and claims 21-23, which depend therefrom, as allegedly being unpatentable over Adamske.

#### **D. Claim 24**

With respect to claim 24, Appellants respectfully submit that the Examiner fails to show that every feature of the claimed invention is taught or suggested by Adamske. For example, as previously argued with respect to claim 12, contrary to the Examiner's assertion, Adamske fails to teach or suggest the claimed means for generating a preview of a configured copy of the document based on the print file and the configuration information on the server. To this extent, Appellants herein incorporate the arguments presented above with respect to claim 12.

Further, contrary to the Examiner's assertion, Adamske fails to teach or suggest the claimed means for obtaining a print file from a client and configuration information for the document on a server, wherein the print file can be directly printed by a printer. To the contrary, as previously argued with respect to claim 20, under both embodiments of Adamske, the print file is generated on a server. Adamske, col. 5, lines 21-24, 64-66; col. 6, lines 50-52. Consequently, Adamske fails to teach or suggest means for obtaining a print file from a client as in the claimed invention.

Further, the Examiner fails to show that Adamske teaches or suggests the claimed means for assembling a copy based on configuration information. In support of the rejection, the Examiner states that Adamske allegedly discloses “style options”. Final Office Action, p. 6. However, Appellants note that the phrase “style options” does not appear anywhere in Adamske. Regardless, the Examiner fails to show that Adamske includes any configuration information that is used both in generating a preview of a configured copy of the document and in assembling a copy of the document as in the claimed invention.

In light of the above, Appellants respectfully submit that the Examiner has failed to show that Adamske teaches or suggests each and every feature of the claimed invention. As a result, Appellants respectfully request overrule of the rejection of claim 24 and claims 25-27, which depend therefrom, as allegedly being unpatentable over Adamske.

#### **E. Claim 29**

With respect to claim 29, Appellants respectfully submit that the Examiner fails to show that every feature of the claimed invention is taught or suggested by Adamske. For example, as previously argued with respect to claim 12, contrary to the Examiner’s assertion, Adamske fails to teach or suggest the claimed program code for generating a preview based on the print file and the configuration information. To this extent, Appellants herein incorporate the arguments presented above with respect to claim 12. Additionally, as previously argued with respect to claim 20, contrary to the Examiner’s assertion, Adamske fails to teach or suggest the claimed program code for generating a print file on a client based on the document, wherein the print file can be directly printed by a printer and program code for communicating the print file to a server as in the claimed invention. To this extent, Appellants herein incorporate the arguments presented above with respect to claim 20.

In light of the above, Appellants respectfully submit that the Examiner has failed to show that Adamske teaches or suggests each and every feature of the claimed invention. As a result, Appellants respectfully request overrule of the rejection of claim 29 and claim 30, which depends therefrom, as allegedly being unpatentable over Adamske.

#### **F. Claim 31**

With respect to claim 31, Appellants respectfully submit that the Examiner fails to show that every feature of the claimed invention is taught or suggested by Adamske. For example, as previously argued with respect to claim 17, contrary to the Examiner's assertion, Adamske fails to teach or suggest the claimed program code for obtaining memo information for each of the plurality of delivery addresses, wherein the memo information is customized for a recipient at each of the plurality of delivery addresses. To this extent, Appellants herein incorporate the arguments presented above with respect to claim 17. Additionally, as previously argued with respect to claim 24, contrary to the Examiner's assertion, Adamske fails to teach or suggest the claimed program code for obtaining a print file and configuration information communicated over a network, wherein the print file is based on the document and the print file can be directly printed by a printer as in the claimed invention. To this extent, Appellants herein incorporate the arguments presented above with respect to claim 24.

In light of the above, Appellants respectfully submit that the Examiner has failed to show that Adamske teaches or suggests each and every feature of the claimed invention. As a result, Appellants respectfully request overrule of the rejection of claim 31 as allegedly being unpatentable over Adamske.

## **II. Rejection of claim 28 as being unpatentable over Adamske in view of Bresnan**

With respect to claim 28, Appellants respectfully submit that the Examiner fails to show that every feature of the claimed invention is taught or suggested by Adamske. For example, as previously argued with respect to claim 12, contrary to the Examiner's assertion, Adamske fails to teach or suggest the claimed generation of a user interface that includes a preview area for displaying a preview that is based on a print file and configuration information for a document. To this extent, Appellants herein incorporate the arguments presented above with respect to claim 12.

Further, the Examiner fails to show that Adamske teaches an "interface [that] provides a preview section and a printing options section that allows a user to provide configuration information (i.e. style options)". Final Office Action, p. 10. Initially, Appellants again note that the phrase "style options" does not appear in Adamske. Further, the Examiner cites col. 7, lines 16-56 of Adamske in support of the rejection. However, this portion of Adamske is unrelated to previewing the document, let alone describing an interface that provides a preview section and a printing options section.

In response to Appellants' arguments, the Examiner apparently alleges that selecting black and white or color printing comprises "style options". Final Office Action, p. 12. However, Appellants note that the user in Adamske is only able to make this selection after the user has verified the print preview, at the operational screen shown in FIG. 3 of Adamske. Adamske, col. 6, lines 58-60. This operational screen clearly does not include both a preview area and a configuration area. To this extent, Appellants submit that Adamske fails to teach the preview area or the configuration area of the claimed invention. The combination of Adamske with Bresnan does not cure this defect.

### III. Conclusion

In summary, Appellants submit that claims 12-33 are allowable because Adamske, taken alone or in combination with Bresnan, fails to meet each of the three basic criteria required to establish a *prima facie* case of obviousness.

Respectfully submitted,



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## CLAIMS APPENDIX

### Claim Listing:

12. A method of previewing a document over a network, the method comprising:
  - providing system software for use on a client, wherein the system software allows a user of the client to generate a print file on the client based on the document using a local application;
  - obtaining the print file from the client on a server;
  - obtaining configuration information for the document on the server;
  - generating a preview of a configured copy of the document on the server based on the print file and the configuration information; and
  - providing the preview for display at the client.
13. The method of claim 12, wherein the providing system software step includes installing at least one print driver for generating the print file on the client.
14. The method of claim 13, further comprising:
  - listing each of the at least one print driver on a list of available printers for the client;
  - selecting one of the at least one print driver using the local application;
  - generating the print file using the one of the at least one print driver; and
  - communicating the print file to the server over the network.
15. The method of claim 12, wherein the providing the preview step includes:
  - generating a configuration user interface on the server, wherein the configuration user interface includes:
    - a preview area for displaying the configured copy of the document; and
    - a printing option area for obtaining the configuration information; and
  - providing the configuration user interface for display at the client.
16. The method of claim 12, wherein the obtaining configuration information step includes:
  - obtaining a style and a printing option for printing the document;
  - modifying the preview based on the print file, the style and the printing option; and
  - providing the modified preview for display at the client.
17. A method of printing a document over a network, the method comprising:
  - obtaining a print file on a server, wherein the print file is based on the document;
  - obtaining configuration information for the document on the server, wherein the configuration information includes at least one printing option for the document;
  - printing a plurality of copies of the document based on the print file and the configuration information;
  - obtaining a plurality of delivery addresses on the server;
  - obtaining memo information for each of the plurality of delivery addresses, wherein the memo information is customized for a recipient at each of the plurality of delivery addresses;
  - printing a customized memo based on the customized memo information for each of the plurality of delivery addresses; and

delivering at least one of the plurality of copies of the document and the corresponding customized memo to each of the plurality of delivery addresses.

18. The method of claim 17, wherein the obtaining configuration information step includes:  
generating a preview of a configured copy of the document on the server based on the print file and the configuration information;

generating a configuration user interface on the server, wherein the configuration user interface includes a preview area for displaying the preview and a printing option area for obtaining a printing option;

providing the configuration user interface for display at the client;  
obtaining the printing option for printing the document;  
modifying the preview based on the print file and the printing option; and  
providing the modified preview for display at the client.

19. The method of claim 17, further comprising:

installing system software on a client, wherein the system software includes at least one print driver for generating the print file and an upload manager for communicating the print file to the server;

listing each of the at least one print driver on a list of available printers for the client;  
selecting one of the at least one print driver using a local application;  
generating the print file using the one of the at least one print driver; and  
communicating the print file to the server over the network using the upload manager.

20. A system for previewing a document over a network, the system comprising:

system software that generates a print file on a client based on the document and communicates the print file to a server, wherein the print file can be directly printed by a printer;  
means for obtaining the print file from the client and configuration information for the document on the server;

means for generating a preview of a configured copy of the document based on the print file and the configuration information on the server; and

means for providing the preview for display at the client.

21. The system of claim 20, wherein the system software includes:

a print driver that generates the print file, wherein the print driver is included on a list of available printers for the client; and  
an upload manager that communicates the generated print file to the server.

22. The system of claim 21, further comprising a local application that generates the document, displays the list of available printers and enables a user to select the print driver from the list of available printers.

23. The system of claim 20, further comprising:

means for generating a configuration user interface on the server, wherein the configuration user interface includes a preview area for displaying the preview and a printing option area for selecting at least one printing option; and

means for providing the configuration user interface for display at the client.

24. A system for printing a document over a network, the system comprising:

means for obtaining a print file from a client and configuration information for the document on a server, wherein the print file can be directly printed by a printer;

means for generating a preview of a configured copy of the document based on the print file and the configuration information on the server;

means for providing the preview for display at the client;

means for printing a copy of the document using the print file; and

means for assembling the copy based on the configuration information.

25. The system of claim 24, further comprising:

means for obtaining a delivery address for the copy; and

means for delivering the copy to the delivery address.

26. The system of claim 24, further comprising:

means for obtaining payment information for the copy; and

means for processing payment for the copy using the payment information.

27. The system of claim 24, further comprising:

a print driver that generates the print file, wherein the print driver is included on a list of available printers for the client; and

an upload manager that communicates the print file to the server.

28. A graphical user interface comprising:

a preview area for displaying a preview of a configured copy of a document, wherein the preview is based on a print file and configuration information for the document;

a navigation area that enables a user to select a portion of the preview displayed in the preview area;

an estimate area for displaying a price estimate for the configured copy, wherein the price estimate is based on the print file and the configuration information; and

a configuration area that enables the user to alter the configuration information, wherein the preview area and the estimate area are automatically updated based on the altered configuration information.

29. A computer program product comprising a computer useable medium having computer readable program code embodied therein for previewing a document, the program product comprising:

program code for generating a print file on a client based on the document, wherein the print file can be directly printed by a printer;

program code for communicating the print file to a server;

program code for installing the program code for generating and program code for communicating on the client, wherein the program code for installing causes an entry to be added to a list of available printers for the client;

program code for obtaining configuration information for the document;

program code for generating a preview based on the print file and the configuration information; and

program code for displaying the preview on the client.

30. The computer program product of claim 29, wherein the program code for installing further installs the program code for obtaining and program code for generating on the client.

31. A computer program product comprising a computer useable medium having computer readable program code embodied therein for printing a document, the program product comprising:

program code for obtaining a print file and configuration information communicated over a network, wherein the print file is based on the document and the print file can be directly printed by a printer;

program code for printing a plurality of copies of the document based on the print file and the configuration information;

program code for obtaining a plurality of delivery addresses;

program code for obtaining memo information for each of the plurality of delivery addresses, wherein the memo information is customized for a recipient at each of the plurality of delivery addresses; and

program code for printing a customized memo based on the customized memo information for each of the plurality of delivery addresses.

32. The method of claim 12, wherein the print file can be directly printed by a printer.

33. The method of claim 12, wherein the print file comprises one of: a PostScript file and a Portable Document Format (PDF) file.

## **EVIDENCE APPENDIX**

No evidence has been entered and relied upon in the appeal.

## **RELATED PROCEEDINGS APPENDIX**

No decisions rendered by a court or the Board in any proceeding are identified in the related appeals and interferences section.